IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Franklin** §	
§	Group Art Unit: **3628**
Serial No. **10/718,095** §	
§	Examiner: **Liou, Eric**
Filed: **November 20, 2003** §	
§	
For: **Dining Preferences Storage** §	
Mechanism §	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on October 25, 2007.

A fee of $510.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

This appeal has no related proceedings or interferences.

STATUS OF CLAIMS

A.   TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are: 1-22

B.   STATUS OF ALL THE CLAIMS IN APPLICATION

Claims canceled: 1-5, 9-13 and 19-22

Claims withdrawn from consideration but not canceled: none

Claims pending: 6-8 and 14-18

Claims allowed: none

Claims rejected: 6-8 and 14-18

Claims objected to: none

C.   CLAIMS ON APPEAL

The claims on appeal are: 6-8 and 14-18

<u>STATUS OF AMENDMENTS</u>

No amendment after final rejection was filed for this case.

SUMMARY OF CLAIMED SUBJECT MATTER

A.   CLAIM 6 - INDEPENDENT

The subject matter of claim 6 is directed to a method for using dining preferences to generate an order. A customer physically presents a smart card to an employee of a restaurant (Specification page 9, lines 27-30. A data processing system reads customer dining preferences for the restaurant from a memory (Specification page 11, line 4; Figure 3, element 304) in the smart card (Specification page 11, lines 1-3; Figure 3, element 300), where this smart card memory includes dining preferences for food items for a set of different and unrelated restaurants (Specification page 11, lines 12-13; page 12, lines 9-16; Figure 4, element 402). The dining preferences (i) are customer-portable between the set of different and unrelated restaurants (Specification page 12, lines 9-13), (ii) are read from the smart card using radio frequency signals (Specification page 11, lines 20-23), and (iii) are stored in association with a restaurant name and a food item name also stored in the smart card (Specification page 14, line 16 – page 15, line 12; Figure 5, element 500). The data processing system displays the dining preferences for the restaurant on a display for order verification by both the employee and the customer (Specification page 13, line 26 – page 14, line 15; page 17, line 13 – page 18, line 24; Figure 4, element 412; Figures 8A-8B, all elements). In doing so, other dining preferences maintained in the smart card for other restaurants are not displayed. The data processing system generates the order using the dining preferences (Specification page 15, line 13 – page 16, line 2; Figure 6, elements 600-608). The smart card also has a communications interface, wherein the communications interface allows for the dining preferences to be read from the memory by the data processing system at the restaurant for use in generating the food order (Specification page 11, lines 13-30; Figure 3, element 306). This communications interface is a radio frequency transceiver that uses the radio frequency signals to read the dining preferences for the restaurant from the smart card and write the dining preferences for the restaurant to the smart card (Specification page 11, lines 20-30; Figure 3, element 306).

B.   CLAIM 15 - INDEPENDENT

The subject matter of claim 15 is directed to a data processing system for using dining preferences to generate an order. The data processing system includes reading means for reading

dining preferences for a restaurant from a memory (Specification page 11, line 4; Figure 3, element 304) in a smart card (Specification page 11, lines 1-3; Figure 3, element 300) for a customer, where the memory includes dining preferences for food items for a set of different and unrelated restaurants (Specification page 11, lines 12-13; page 12, lines 9-16; Figure 4, element 402). The dining preferences (i) are customer-portable between the set of different and unrelated restaurants (Specification page 12, lines 9-13), (ii) are read from the smart card using radio frequency signals (Specification page 11, lines 20-23), and (iii) are stored in association with a restaurant name and a food item name also stored in the smart card (Specification page 14, line 16 – page 15, line 12; Figure 5, element 500). The data processing system also includes a displaying means for displaying the dining preferences for the restaurant on a display for order verification by both an employee of the restaurant and the customer, where other dining preferences maintained in the smart card for other restaurants are not displayed (Specification page 13, line 26 – page 14, line 15; page 17, line 13 – page 18, line 24; Figure 4, element 412; Figures 8A-8B, all elements). The data processing system also includes a generating means for generating the order using the dining preferences (Specification page 15, line 13 – page 16, line 2; Figure 6, elements 600-608). The smart card also includes a communications interface, where the communications interface allows for the dining preferences to be read from the memory by a data processing system at the restaurant for use in generating the food order (Specification page 11, lines 13-30; Figure 3, element 306). The communications interface is a radio frequency transceiver that uses the radio frequency signals to read the dining preferences from the smart card and write the dining preferences to the smart card (Specification page 11, lines 20-30; Figure 3, element 306).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

A.   **GROUND OF REJECTION 1**

Whether the Examiner failed to state a *prima facie* obviousness rejection under 35 U.S.C. § 103 against Claims 6-8 and 14-18 over Grimes, "Smart Cards Help Operators Build Better Customer Relations, Nation's Restaurant News, March 30, 1998, No. 13, Vol. 32, pg.54 in view of Elliot, U.S. Patent No. 6,366,220.

ARGUMENT

A.   GROUND OF REJECTION 1 (Claims 6-8 and 14-18)

Claims 6-8 and 14-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over over Grimes, "Smart Cards Help Operators Build Better Customer Relations, Nation's Restaurant News, March 30, 1998, No. 13, Vol. 32, pg.54 in view of Elliott, U.S. Patent No. 6,366,220.

1.   *Claims 6-8 and 14-18*

Generally speaking, the features per amended Claim 6 advantageously provide improvements over the teachings/suggestions of the cited references – and in particular, such features advantageously provide *a user-portable smart card with dining preferences stored therein that are interoperable between a multitude of different restaurants using a single card* (i.e. "multi-vendor interchange"), as described at Specification page 14, lines 3-15 et seq.

Specifically with respect to Claim 6, such claim recites "reading, by a data processing system, customer dining preferences for the restaurant from a memory in the smart card, wherein the memory includes dining preferences for food items for a set of different and unrelated restaurants, wherein the dining preferences (i) are customer-portable between the set of different and unrelated restaurants, (ii) are read from the smart card using radio frequency signals, and (iii) are stored in association with a restaurant name and a food item name also stored in the smart card". In rejecting Claim 6, the Examiner states that it would have been obvious to modify the dining preference teachings of Grimes to include dining preferences for a set of different and unrelated restaurants for the advantage of conveniently storing preferences for all restaurants that a user plans to visit on one card. Appellant urges error, as the Examiner has failed to properly establish a prima facie showing of obviousness by such 'obvious to modify' assertion, as the Examiner merely provides subjective opinion without supporting objective evidence to substantiate such subjective opinion. To establish prima facie obviousness of a claimed invention, _all of the claim limitations_ must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992). Thus, it is urged that Claim 6 has been erroneously rejected due to such prima facie deficiency.

Further with respect to Claim 6, and as previously described, such claim recites that the dining preferences in the smart card memory are stored in association with *both* (i) a restaurant name and (ii) a food item name. In rejecting Claim 6, the Examiner states that these two claimed stored items are taught by Grimes at paragraph 0012 since the restaurant recognizes the food item name for the particular restaurant when the smart card is read by the reader. Appellant urges error, as this cited passage does not teach the storing of both a restaurant name and a food item name on the smart. For example, it is possible that the card is specific for a given restaurant based on a logo printed on the outside of the card which the customer uses to identify which card to present at a given restaurant. It is also possible that the card stores generic preferences that are not specific for a given restaurant. "To establish inherency," the Federal Circuit recently stated, "the extrinsic evidence `must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."' *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by "`probabilities or possibilities.'" *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). It is respectfully submitted that a teaching of 'meal preferences' as described by Grimes does not establish a teaching that dining preferences in the smart card memory are stored in association with (i) a restaurant name and (ii) a food item name. For example, a food name may be a chicken teriyaki, and the dining preferences may be particular specific items the user prefers with such chicken teriyaki (Figure 8B). It is quite possible the Grimes 'meal preferences' merely state a name of an item that is preferred, such as 'chicken steak' or 'vegetarian' or 'allergic to peanuts', etc. without further preference qualification. Thus, it is further shown that the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 6 as Grimes merely teaches the existence of 'meal preferences' without further qualification.

Still further with respect to Claim 6, the Examiner acknowledges that the cited Grimes reference does not teach a radio frequency transceiver that reads and writes information to the card, but states that Elliot discloses reading information from a card using radio frequency signals, citing Elliott teaching at col. 5, lines 24-33. Appellant urges that while Elliot may describe *reading*

information in this cited passage, there is no teaching or suggestion of any ability to _write dining preferences_ to the smart card _using a radio frequency transceiver_, as expressly recited in Claim 6. Thus, it is further shown that the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 6 as Elliott merely teaches an ability to read 'identification information' which identifies a user, which is then used to query a given customers' account to ascertain menu preferences of the identified user (Elliot col. 5, lines 24-33). Therefore, there would be no reason for Elliot to use a radio frequency transceiver to _write_ _dining preferences to a smart card_, as Elliot is architected in a fundamentally different fashion where menu preferences are stored in a database that is accessed using user identification information read from the card.

Still further, per the teachings of the cited Elliott reference, and directly tied to the overall architecture provided by the Elliott teachings, the so-called 'default menu' for placing an order is only with respect to a _given restaurant_ (and thus is not interoperable between a multitude of different and unrelated restaurants). This is _required by the teachings of Elliott_ since the RFID tag that is used to facilitate customer food orders _only has RFID tag identification information_ that can be read from such RFID tag (col. 1, lines 19-20, lines 51-58; col. 5, lines 27-35). This RFID tag identifier is read and used to look-up a given account from a different system in order to query a customer account (col. 1, lines 20-35; col. 3, lines 41-45). It is not possible to store any type of dining preferences for a customer in such an RFID tag. In addition, because the tag identifier is used to identify a customer, which is either (i) used locally in conjunction with a particular vendor-specific database (col. 5, lines 28-30) and thus the restaurant is already implicitly known by physical proximity, or (ii) transmitted by the food vendor themselves to a tag-vendor for processing (col. 5, lines 64 – col. 6, line 15) and thus the restaurant is known by the food-vendor/tag-vendor link, there would be no need or reason to include particular restaurant identification capabilities within a card or tag itself in the Elliott described system. Claim 6 expressly recites that restaurant identification is stored in the smart card itself.

While Elliott also nominally mentions use of an active RFID in other, different applications, this tag description does not provide any type of multi-vendor interchange capabilities or memory read/write capability with respect to restaurants or customer food preferences. Instead, the active RFID tag is described as being used in complex applications such as maintaining maintenance information for the automobile for which such tag is affixed to. Due to the _direct linkage_ between the item (automobile) that the RFID tag is affixed to and the particular information stored therein

(maintenance information for this same automobile), a person would not have been motivated to modify this description in accordance with the above described missing claimed features, as the advantages provided by this direct linkage and device affixation would be lost.

In addition, Elliot explicitly states a strong desire to provide a conglomerated database that maintains customer account information, including menu preferences of such customers (col. 5, lines 24-40). This central data storage, which is not accessible by an end user but instead is controlled by the restaurant/food vendor themselves, is desired to further facilitate related ongoing business operations by the food vendor, including ordering supplies, computing budgets, tracking customer preferences and creating sales promotions (Elliott col. 6, lines 31-36). Thus, there would have been no reason or desire for a person of ordinary skill in the art, when presented with the Elliott teachings, to somehow re-architect the entire Elliott system to provide a de-centralized system where customer food preferences are distributed to or maintained by each customer individually, due to the desire for having a conglomerate customer database with associated customer account information consolidated together under a central control.

Thus, a person of ordinary skill in the art would not have been motivated to modify such Elliot teachings in accordance with the missing claimed features recited in Claim 6, which are (1) reading customer dining preferences for the restaurant from a memory in the smart card, *wherein the memory includes dining preferences for food items for a set of different and unrelated restaurants, wherein the dining preferences (i) are customer-portable between the set of different and unrelated restaurants, (ii) are read from the smart card using radio frequency signals, and (iii) are stored in association with <u>a restaurant name and a food item name also stored in the smart card</u>*; (2) displaying the dining preferences for the restaurant on a display for <u>*order verification by both the employee and the customer,*</u> *wherein other dining preferences maintained in the smart card for other restaurants are not displayed*; and (3) a smart card that comprises a communications interface, wherein *the communications interface allows for the dining preferences to be read from the memory by a data processing system at the restaurant for use in generating the food order*, wherein the communications interface is a radio frequency transceiver that uses the radio frequency signals to read the restaurant dining preferences from the smart card and *<u>write</u> the restaurant dining preferences to the smart card.*

Thus, it is urged that the a proper prima facie case of obviousness has not been established under 35 U.S.C. § 103 with respect to Claim 6.

C. CONCLUSION

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellant requests that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellant requests that the Board direct the Examiner to allow the claims.

/Wayne P. Bailey/
Wayne P. Bailey
Reg. No. 34,289
YEE & ASSOCIATES, P.C.
PO Box 802333
Dallas, TX 75380
(972) 385-8777

CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

6.   A method for using dining preferences to generate an order, the method comprising:

physically presenting, by a customer, a smart card to an employee of a restaurant;

reading, by a data processing system, customer dining preferences for the restaurant from

a memory in the smart card, wherein the memory includes dining preferences for food items for a

set of different and unrelated restaurants, wherein the dining preferences (i) are customer-

portable between the set of different and unrelated restaurants, (ii) are read from the smart card

using radio frequency signals, and (iii) are stored in association with a restaurant name and a

food item name also stored in the smart card;

displaying, by the data processing system, the dining preferences for the restaurant on a

display for order verification by both the employee and the customer, wherein other dining

preferences maintained in the smart card for other restaurants are not displayed; and

generating, by the data processing system, the order using the dining preferences;

wherein the smart card further comprises a communications interface, wherein the

communications interface allows for the dining preferences to be read from the memory by the

data processing system at the restaurant for use in generating the food order, wherein the

communications interface is a radio frequency transceiver that uses the radio frequency signals to

read the dining preferences for the restaurant from the smart card and write the dining

preferences for the restaurant to the smart card.

7.   The method of claim 6, wherein the smart card further comprises a processor embedded within the smart card.

8.   The method of claim 6 further comprising:

initiating the generating step after a user input confirming the dining preferences for the order.

14.   The method of claim 6, wherein the dining preferences are generated by a terminal at the restaurant and stored in the smart card at the restaurant.

15.   A data processing system in a data processing system for using dining preferences to generate an order, the data processing system comprising:

reading means for reading dining preferences for a restaurant from a memory in a smart card for a customer, wherein the memory includes dining preferences for food items for a set of different and unrelated restaurants, wherein the dining preferences (i) are customer-portable between the set of different and unrelated restaurants, (ii) are read from the smart card using radio frequency signals, and (iii) are stored in association with a restaurant name and a food item name also stored in the smart card;

displaying means for displaying the dining preferences for the restaurant on a display for order verification by both an employee of the restaurant and the customer, wherein other dining preferences maintained in the smart card for other restaurants are not displayed; and

generating means for generating the order using the dining preferences;

wherein the smart card further comprises a communications interface, wherein the

communications interface allows for the dining preferences to be read from the memory by a data processing system at the restaurant for use in generating the food order, wherein the communications interface is a radio frequency transceiver that uses the radio frequency signals to read the dining preferences from the smart card and write the dining preferences to the smart card.

16.   The data processing system of claim 15, wherein the dining preferences are generated by a terminal at the restaurant and stored in the smart card at the restaurant.

17.   The data processing system of claim 15 further comprising:

initiating means for initiating the generating means after a user input confirming the dining preferences for the order.

18.   The data processing system of claim 15, wherein the smart card further comprises a processor embedded within the smart card.

EVIDENCE APPENDIX

This appeal brief presents no additional evidence.

RELATED PROCEEDINGS APPENDIX

This appeal has no related proceedings.